

1 HONORABLE JAMES L. ROBART
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IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

10 MICROSOFT CORPORATION,

11 Plaintiff,

12 vs.

13 MOTOROLA, INC., et al.,

14 Defendants.

15

MOTOROLA MOBILITY LLC, et al.,

16 Plaintiffs,

17 vs.

18 MICROSOFT CORPORATION,

19 Defendant.

20 Case No. C10-1823-JLR

21 PLAINTIFF MICROSOFT
22 CORPORATION'S MOTION TO
23 QUASH SUBPOENA OF JONATHAN
24 CARUANA

25 **NOTED FOR:**
Monday, November 19, 2012

PLAINTIFF MICROSOFT CORPORATION'S
MOTION TO QUASH SUBPOENA OF
JONATHAN CARUANA

LAW OFFICES
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1 Microsoft hereby moves to quash Motorola's trial subpoena to Jonathan Caruana, a
 2 Microsoft employee that Motorola had not previously identified as a potential witness.

3 **BACKGROUND**

4 At about 3:30 PM on Friday, November 16, 2012, the parties and the Court discussed
 5 the timing of Motorola's disclosure of its witness list for Monday, November 19, in light of the
 6 fact that Motorola had identified 12 remaining witnesses but had only a limited amount of trial
 7 time remaining. The parties and the Court discussed the possibility of Motorola dropping
 8 witnesses in the interests of time, and the Court stated that it expected that Motorola would
 9 promptly notify Microsoft when it had decided that any witness would not be called. With no
 10 advance notice or explanation, at 5:41 PM on Friday (just two hours later), Motorola's counsel
 11 sent Microsoft's counsel an email with an attached trial subpoena for a 13th witness, Microsoft
 12 employee Jonathan James Caruana, commanding him to appear at trial on Monday, November
 13 19 at 9:00 AM. *See Ex. A.*¹ The subpoena issued from the Western District of Washington.

14 *Id.*

15 **ARGUMENT**

16 Federal Rule of Civil Procedure 45 states that an issuing court "must quash or modify a
 17 subpoena that fails to allow a reasonable time to comply." Fed. R. Civ. P. 45(c)(3)(A)(i).

18 The subpoena should be quashed because it fails to allow a reasonable time to comply.
 19 Motorola sent the subpoena to Microsoft after the close of the business day on Friday,
 20 demanding Mr. Caruana's appearance at trial at 9 AM Monday. There is no justification for
 21 this eleventh-hour demand for Mr. Caruana's testimony. Mr. Caruana was not on Motorola's
 22 trial witness list, *see* Dkt. No. 493, Pretrial Order at 16–19, nor was he on Microsoft's, *id.* at
 23 12–16. Motorola is well aware of Mr. Caruana's knowledge of the Xbox—on June 24, 2011,
 24

25 ¹ The subpoena is directed to "Jonathon James Caruana." Microsoft assumes Motorola's intention was to
 subpoena Microsoft employee Jonathan James Caruana.

1 Motorola took his deposition in connection with Motorola's ITC case against the Xbox, and
 2 cross-examined him in the ITC trial on January 12, 2012. But Motorola gave Microsoft no
 3 notice that it had any intention of calling Mr. Caruana until the subpoena arrived, two-thirds of
 4 the way through this trial, far too late for Microsoft to meaningfully prepare for Mr. Caruana's
 5 examination. Indeed, because Motorola refused to drop even a single witness by 4:30 PM on
 6 Saturday, Microsoft is currently preparing for cross-examinations of 12 witnesses that
 7 Motorola claims it will call across two days. Motorola provided neither Mr. Caruana nor
 8 Microsoft any reasonable amount of time to prepare to testify in this trial. The fact that Mr.
 9 Caruana was both deposed and cross-examined by Motorola in a related proceeding involving
 10 the same issues makes Motorola's tardy subpoena to Mr. Caruana all the more inexcusable.

11 The subpoena to Mr. Caruana is untimely, improper in light of the Court's pretrial
 12 order, and unjustifiable. Motorola had access to Mr. Caruana long before this trial began—if it
 13 believed him an important witness, its obligation was to identify him in a timely fashion.
 14 Motorola ignored him until after the close of the fourth of six days of trial. His introduction
 15 into the case now would prejudice Microsoft as both a distraction and a waste of time. Further,
 16 assuming that Motorola intends to examine Mr. Caruana concerning his knowledge of
 17 confidential and commercially-sensitive aspects of the Xbox 360, that examination would
 18 require either disclosure of Microsoft's confidential information, or closing and re-opening the
 19 courtroom, wasting even more of the limited remaining trial time. The subpoena to Mr.
 20 Caruana should be quashed.

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DATED this 18th day of November, 2012.

CALFO HARRIGAN LEYH & EAKES LLP

By s/ Arthur W. Harrigan, Jr.
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Counsel for Microsoft Corp.

CERTIFICATE OF SERVICE

I, SUSIE CLIFFORD, swear under penalty of perjury under the laws of the State of Washington to the following:

1. I am over the age of 21 and not a party to this action.
2. On the 18th day of November, 2012, I caused the preceding document to be on counsel of record in the following manner:

Attorneys for Motorola Solutions, Inc., and Motorola Mobility, Inc.:

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10 DATED this 18th day of November, 2012.
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7 s/Susie Clifford
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PLAINTIFF MICROSOFT CORPORATION'S
MOTION TO QUASH SUBPOENA OF
JONATHAN CARUANA - 5

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EXHIBIT A

AO 88 (Rev. 07/10) Subpoena to Appear and Testify at a Hearing or Trial in a Civil Action

UNITED STATES DISTRICT COURT
 for the
 Western District of Washington

MICROSOFT CORPORATION)	
Plaintiff)	
v.)	Civil Action No. C10-1823-JLR
MOTOROLA, INC., et al.)	
Defendant)	

**SUBPOENA TO APPEAR AND TESTIFY
 AT A HEARING OR TRIAL IN A CIVIL ACTION**

To: Jonathon James Caruana

YOU ARE COMMANDED to appear in the United States district court at the time, date, and place set forth below to testify at a hearing or trial in this civil action. When you arrive, you must remain at the court until the judge or a court officer allows you to leave.

Place: United States District Court 700 Stewart Street Seattle, WA 98101	Courtroom No.: 14106 Date and Time: 11/19/2012 9:00 am
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You must also bring with you the following documents, electronically stored information, or objects (*blank if not applicable*):

The provisions of Fed. R. Civ. P. 45(c), relating to your protection as a person subject to a subpoena, and Fed. R. Civ. P. 45 (d) and (e), relating to your duty to respond to this subpoena and the potential consequences of not doing so, are attached.

Date: 11/16/2012

CLERK OF COURT

OR

Signature of Clerk or Deputy Clerk

Attorney's signature

The name, address, e-mail, and telephone number of the attorney representing (*name of party*) Motorola, Inc., Motorola

Mobility LLC and General Instrument Corp., who issues or requests this subpoena, are:

Ralph H. Palumbo, WSBA #04751, Philip S. McCune, WSBA #21081, Lynn M. Engel, WSBA #21934
 ralph@summitlaw.com; philm@summitlaw.com; lynne@summitlaw.com
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AO 88 (Rev.07/10) Subpoena to Appear and Testify at a Hearing or Trial in a Civil Action (page 2)

Civil Action No. C10-1823-JLR

PROOF OF SERVICE

(This section should not be filed with the court unless required by Fed. R. Civ. P. 45.)

This subpoena for *(name of individual and title, if any)* Jonathon James Caruana
was received by me on *(date)* _____.

I served the subpoena by delivering a copy to the named person as follows: _____

on *(date)* _____; or

I returned the subpoena unexecuted because: _____

Unless the subpoena was issued on behalf of the United States, or one of its officers or agents, I have also tendered to the witness fees for one day's attendance, and the mileage allowed by law, in the amount of

\$ 54.30 .

My fees are \$ _____ for travel and \$ _____ for services, for a total of \$ 0.00 .

I declare under penalty of perjury that this information is true.

Date: _____

Server's signature

Printed name and title

Server's address

Additional information regarding attempted service, etc:

Federal Rule of Civil Procedure 45 (c), (d), and (e) (Effective 12/1/07)**(c) Protecting a Person Subject to a Subpoena.**

(1) **Avoiding Undue Burden or Expense; Sanctions.** A party or attorney responsible for issuing and serving a subpoena must take reasonable steps to avoid imposing undue burden or expense on a person subject to the subpoena. The issuing court must enforce this duty and impose an appropriate sanction — which may include lost earnings and reasonable attorney's fees — on a party or attorney who fails to comply.

(2) Command to Produce Materials or Permit Inspection.

(A) **Appearance Not Required.** A person commanded to produce documents, electronically stored information, or tangible things, or to permit the inspection of premises, need not appear in person at the place of production or inspection unless also commanded to appear for a deposition, hearing, or trial.

(B) **Objections.** A person commanded to produce documents or tangible things or to permit inspection may serve on the party or attorney designated in the subpoena a written objection to inspecting, copying, testing or sampling any or all of the materials or to inspecting the premises — or to producing electronically stored information in the form or forms requested. The objection must be served before the earlier of the time specified for compliance or 14 days after the subpoena is served. If an objection is made, the following rules apply:

(i) At any time, on notice to the commanded person, the serving party may move the issuing court for an order compelling production or inspection.

(ii) These acts may be required only as directed in the order, and the order must protect a person who is neither a party nor a party's officer from significant expense resulting from compliance.

(3) Quashing or Modifying a Subpoena.

(A) **When Required.** On timely motion, the issuing court must quash or modify a subpoena that:

(i) fails to allow a reasonable time to comply;

(ii) requires a person who is neither a party nor a party's officer to travel more than 100 miles from where that person resides, is employed, or regularly transacts business in person — except that, subject to Rule 45(c)(3)(B)(iii), the person may be commanded to attend a trial by traveling from any such place within the state where the trial is held;

(iii) requires disclosure of privileged or other protected matter, if no exception or waiver applies; or

(iv) subjects a person to undue burden.

(B) **When Permitted.** To protect a person subject to or affected by a subpoena, the issuing court may, on motion, quash or modify the subpoena if it requires:

(i) disclosing a trade secret or other confidential research, development, or commercial information;

(ii) disclosing an unretained expert's opinion or information that does not describe specific occurrences in dispute and results from the expert's study that was not requested by a party; or

(iii) a person who is neither a party nor a party's officer to incur substantial expense to travel more than 100 miles to attend trial.

(C) **Specifying Conditions as an Alternative.** In the circumstances described in Rule 45(c)(3)(B), the court may, instead of quashing or modifying a subpoena, order appearance or production under specified conditions if the serving party:

(i) shows a substantial need for the testimony or material that cannot be otherwise met without undue hardship; and

(ii) ensures that the subpoenaed person will be reasonably compensated.

(d) Duties in Responding to a Subpoena.

(1) **Producing Documents or Electronically Stored Information.** These procedures apply to producing documents or electronically stored information:

(A) **Documents.** A person responding to a subpoena to produce documents must produce them as they are kept in the ordinary course of business or must organize and label them to correspond to the categories in the demand.

(B) **Form for Producing Electronically Stored Information Not Specified.** If a subpoena does not specify a form for producing electronically stored information, the person responding must produce it in a form or forms in which it is ordinarily maintained or in a reasonably usable form or forms.

(C) **Electronically Stored Information Produced in Only One Form.** The person responding need not produce the same electronically stored information in more than one form.

(D) **Inaccessible Electronically Stored Information.** The person responding need not provide discovery of electronically stored information from sources that the person identifies as not reasonably accessible because of undue burden or cost. On motion to compel discovery or for a protective order, the person responding must show that the information is not reasonably accessible because of undue burden or cost. If that showing is made, the court may nonetheless order discovery from such sources if the requesting party shows good cause, considering the limitations of Rule 26(b)(2)(C). The court may specify conditions for the discovery.

(2) Claiming Privilege or Protection.

(A) **Information Withheld.** A person withholding subpoenaed information under a claim that it is privileged or subject to protection as trial-preparation material must:

(i) expressly make the claim; and

(ii) describe the nature of the withheld documents, communications, or tangible things in a manner that, without revealing information itself privileged or protected, will enable the parties to assess the claim.

(B) **Information Produced.** If information produced in response to a subpoena is subject to a claim of privilege or of protection as trial-preparation material, the person making the claim may notify any party that received the information of the claim and the basis for it. After being notified, a party must promptly return, sequester, or destroy the specified information and any copies it has; must not use or disclose the information until the claim is resolved; must take reasonable steps to retrieve the information if the party disclosed it before being notified; and may promptly present the information to the court under seal for a determination of the claim. The person who produced the information must preserve the information until the claim is resolved.

(e) **Contempt.** The issuing court may hold in contempt a person who, having been served, fails without adequate excuse to obey the subpoena. A nonparty's failure to obey must be excused if the subpoena purports to require the nonparty to attend or produce at a place outside the limits of Rule 45(c)(3)(A)(ii).